

REMARKS

Claims 42-43, 46-54, 57, 60-64, 74 and 77-79 are pending. By this amendment, new claims 77-79 are added and claim 73 is canceled without prejudice. No new matter is introduced. Claims 77-79 are supported at least by Figure 14, Figure 12B, page 44, lines 21-25, page 17, lines 1-5, and page 49, lines 12-15 of the present application. Claims 77-79 are allowable over the art of record at least since the art of record does not disclose “wherein at least one of the tuners and at least one of the audio decompressors are located on an upgrade card inserted into an existing set top terminal,” “[a] set top terminal...comprising: first signal processing components...second signal processing components...and an upgrade port capable of receiving a hardware upgrade,” or “wherein the second signal processing components are located on an expansion card inserted into the apparatus.” Allowance of the pending claims is therefore respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 112

A. Rejections Under 35 U.S.C. § 112, First Paragraph

As discussed during the Interview, claim 42-43, 46-54, 57, 60-64, 73 and 74 are rejected under 35 U.S.C. § 112, first paragraph in Paper No. 8, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Specifically, the Paper No. 8 states that the specification and drawings fail to support the feature in claim 42 that “the second signal processing components are located on an upgrade card.” During the Interview, the Applicants’ representative showed how this feature is supported by the specification, as discussed in the June 23, 2003 Amendment and Response.

In the Advisory Action of July 23, 2003, the Examiner withdrew his indication that Applicants’ arguments overcame the 112 rejection. The statements in the Advisory Action indicate a misunderstanding of the relevance of Figure 14 to Applicants’ arguments showing that claim 42 is fully compliant with section 112. Moreover, the Advisory Action seems to indicate a belief that Figure 14 is the *only* embodiment taught by the present invention for implementing the picture-on-picture capability. This is simply not correct; the present application explicitly states “Figure 14 diagrams *one embodiment* for implementing the picture-on-picture capability.”

Page 14, lines 18-19. Consequently, Figure 14 is just one example of how the teachings of the present application can be used to implement picture-on-picture capability.

Applicants did not argue that Figure 14 explicitly illustrates the embodiment in claim 42. Rather, Applicants referred to Figure 14 because it does inform as to what components shown are part of a hardware upgrade to provide picture-on-picture capability to the set top terminal 220 (“...users who desire a picture-on-picture capability can be provided with a set top terminal 220 having (sic) upgraded hardware components...,” page 49, lines 12-14).¹ As discussed with the Examiner and apparent from the description of Figure 14, all of the components with a primed reference number (*e.g.*, tuner 603' or video decompressor 620') in Figure 14 are the picture-on-picture hardware upgrade (*i.e.*, the “second signal processing components”) to set top terminal 220. As indicated in the sections cited by Applicants, the present application teaches that any such hardware upgrade can be included on an expansion card. “Thus, an expansion card may...be designed to accommodate any hardware upgrade compatible with the set top terminal 220,” [Emphasis added] page 44, lines 21-25. This statement does not include any limitations or conditions. It is not limited to certain hardware upgrades, certain Figures (as suggested in the Advisory Action), or any particular embodiment(s). Therefore, the hardware upgrade components shown with the primed reference numbers in Figure 14 clearly meet the condition “any hardware upgrade.” Consequently, this statement is a clear teaching that the present application describes and enables an embodiment for implementing the picture-on-picture capability in which the hardware upgrade components shown with the primed reference numbers are located on a card insertable into an existing set top terminal.

As a result, the specification and drawings reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the invention claimed in claims 42-43, 46-54, 57, 60-64, 74 and 77-79. Withdrawal of the rejection under 35 U.S.C. § 112, first paragraph, is respectfully requested.

¹ Figure 4 was similarly cited to as further illustrating that the primed reference number components in Figure 14, which do not appear in Figure 4, are the hardware upgrade providing the picture-on-picture capability.

II. CONCLUSION

In view of the above remarks and the corresponding discussion during the Interview, Applicants respectfully submit that the application is in condition for allowance. Prompt examination and allowance are respectfully requested.

Should the Examiner believe that anything further is desired in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. Wooden', is written over a horizontal line.

Date: October 21, 2003

Sean S. Wooden
Registration No. 43,997
Andrews Kurth LLP
1701 Pennsylvania Ave, N.W.
Suite 300
Washington, DC 20006
Tel. (202) 662-2736
Fax (202) 662-2739